

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 1-3 and 5-8 are now present in the application. Claim 1 is independent.

Favorable reconsideration and allowance of this application, as amended, is respectfully requested in view of the following remarks.

Examiner Interview

Applicant wishes to thank Examiner Morrison for the courtesies extended to Applicant's representative Mr. Paul T. Sewell during a personal interview, which was conducted on September 8, 2008 at the USPTO. During the interview the propriety of the combinations of Takahashi and JP'467, Takahashi and Watanabe and Takahashi and Goto were discussed, as well as the issue concerning whether Takahashi may be construed as having a surface smoothed to have a gloss. While the Examiner indicated that some of the rejections of record might be considered to be less strong than others, he remained of the position that the claims of record were unpatentable for essentially the reasons presented in the response to our arguments in the instant Office Action of record. The Office Action and positions taken have been carefully reviewed in light of the discussions which occurred during the interview, in which the Examiner expressed the opinion that the mere expression of a mean surface roughness was insufficient to establish a patentable difference over the prior art. Accordingly, the claims have been amended to present features that define a surface smoothed to have a gloss by the additional parameters not shown or taught by the prior art of record. Every effort has been made to bring the prosecution to a prompt and favorable conclusion. Each issue raised in the Office Action is addressed below. Reconsideration and allowance of the pending claims are respectfully requested in view of the following remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 3 and 5-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,725,209 to Takahashi et al. ("Takahashi") in view of Japanese Publication No. 9-39467, which the Examiner terms "JP'467". Claims 1 and 5-8 stand

rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takahashi in view of U.S. Patent No. 6,030,328 to Watanabe et al. ("Watanabe"). Claims 1 and 5-8 stand rejected 35 U.S.C. § 103(a) as allegedly being unpatentable over Takahashi in view of U.S. Patent No. 5,722,026 to Goto et al. ("Goto"). Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverses these rejections.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. See *M.P.E.P.* § 706.02(j); *M.P.E.P.* 2141-2144.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicant respectfully submits that independent claim 1 has been amended to recite a combination of elements in a sheet feeder reverse roller wherein the coating layer has a mean surface roughness R_a satisfying the following formula: $0.09 \leq R_a \leq 0.11$; and a maximum height R_y , a ten-points mean roughness R_z and a maximum roughness R_{max} that fall within the range of the following formulae: $0.46 \leq R_y \leq 0.60$; $0.39 \leq R_z \leq 0.80$; $13.20 \leq R_{max} \leq 35.36$. Applicant respectfully submits that this combination of elements as now set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Takahashi, JP'467, Watanabe and Goto.

The Examiner states that it is obvious to combine the surface roughness teachings of the secondary references with those of Takahashi. Takahashi does not teach or suggest the claimed variables that result in this specific gloss. Applicant respectfully submits that, even if it were obvious to make the alleged combinations, which we do not admit, claim 1 as now amended would not be taught. None of the prior art of record, including Takahashi, JP'467, Watanabe and Goto show or suggest the combination of a mean surface roughness R_a satisfying the following formula: $0.09 \leq R_a \leq 0.11$; and a maximum height R_y , a ten-points mean roughness R_z and a maximum roughness R_{max} that fall within the range of the following formulae: $0.46 \leq R_y \leq 0.60$; $0.39 \leq R_z \leq 0.80$; $13.20 \leq R_{max} \leq 35.36$, which thereby results in a specific surface gloss. Applicants respectfully submit that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Takahashi, JP'467, Watanabe

and Goto, for the reasons explained above. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

The rejection based on Takahashi and Watanabe suffers from the same deficiency of Takahashi noted above and because Watanabe is for a high nip pressure calendering roll having a surface roughness of less than $0.5\mu\text{m}$, preferably less than $0.2\mu\text{m}$ and desirably less than $0.1\mu\text{m}$. These references cannot be combined, and even if they were combined, they would not teach the embodiment of claims 1 and 5-8. The claimed reverse roller sponge member coating layer surface smoothed "to have a gloss" is not shown by the reference and has not been properly addressed in the rejection.

Moreover, Watanabe is for a high nip pressure calendering roll having a surface roughness of less than $0.5\mu\text{m}$, preferably less than $0.2\mu\text{m}$ and desirably less than $0.1\mu\text{m}$. Watanabe wants the roll surface to be as smooth as possible because it is used to smooth the metal oxide layer on recording tape. Once again, Watanabe does not set a lower limit for the surface smoothness and the wide range of acceptable roughness is so far in excess of the claimed acceptable range as to not meet the standard for obviousness discussed above. Here, it is submitted that only Applicant has recognized that this particular range produces the desired outcome in this particular environment. Therefore, at least because Takahashi and Watanabe fail to show or suggest all of the features of claim 1, it is submitted that claim 1 is patentable over these references, and dependent claims 5-8 are also patentable at least for the same reasons as claim 1.

The rejection based on Takahashi and Goto suffers from the same deficiency of Takahashi noted above and because Goto is for a toner heat fixing roller having a surface roughness R_a in a range of 0.1 to $1\mu\text{m}$. Heat fixing rollers operate under high pressure and high temperature to fix a recording material to a sheet substrate, not to gently return a misfed sheet to a pickup section. Like the other proposed combinations discussed above, the Examiner has laid out no factual analysis that establishes why one working in the art of sheet pickup sections would turn to the art of fixing printing material such as ink or toner under high heat and pressure for solutions to problems. These references cannot be combined, and even if they were combined they would not teach the embodiment of claims 1 and 5-8. The claimed reverse roller sponge

member coating layer surface smoothed “to have a gloss” is not shown by the reference and has not been properly addressed in the rejection. Therefore, at least because Takahashi and Goto fail to show or suggest all of the features of claim 1, it is submitted that claim 1 is patentable over these references, and dependent claims 5-8 are also patentable at least for the same reasons as claim 1.

With respect to the rejections of dependent claim 2, the Examiner optionally includes Kohler to the combination. Kohler relates to forming a rough surface to have a tread for gripping by means of coating. Kohler teaches away from having a gloss surface and teaches away from having a mean surface roughness as claimed. Therefore Kohler cannot remedy the defects of the combinations noted above.

In conclusion, Takahashi discloses a basic construction of a reverse roller 201, but it does not have a coating layer surface smoothed to a gloss and does not have a surface roughness of $0.09 \leq Ra \leq 0.11$, and a maximum height Ry , a ten-points mean roughness Rz and a maximum roughness $Rmax$ that fall within the range of the following formulae: $0.46 \leq Ry \leq 0.60$; $0.39 \leq Rz \leq 0.80$; $13.20 \leq Rmax \leq 35.36$. Neither Watanabe, Goto or Kohler have anything to do with reverse rollers, much less disclose that Ra of a reverse roller should be set within a range of $0.09 \leq Ra \leq 0.11$, and therefore none of these references can be combined with the roller of Takahashi in the manner proposed by the rejections of record for the reasons set forth above.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

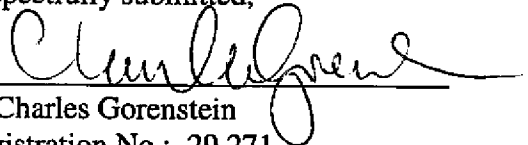
All of the stated grounds of rejection have been properly traversed, accommodated and rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Charles Gorenstein, Reg. No. 29,271 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: September 10, 2008

Respectfully submitted,

By 
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